

REMARKS

Claims 19-38 were pending and were examined. Applicants note the withdrawal of the indication of allowability for claims 19-38. As previously pending claims 1-18 have been canceled in view of the allowability of claims 19-38, Applicants now submit new claims 39-56 which correspond exactly to originally pending claims 1-18. Re-examination and reconsideration of all pending claims is requested in view of the following remarks.

The issues are well defined. The claims cover systems of removable orthodontic appliances, of the type described in U.S. Patent No. 5,975,893, which have been modified with a lubricious composition, typically coated over an interior surface of the appliance in the form of a polymeric shell. Claims 18-38 cover methods for making such appliances. Claims 39-44 cover systems comprising such appliances. Claims 45-56 cover methods for using such appliances.

Pending claims 18-38 were rejected over the combination of Chishti et al '893 and Morrow et al. '689. The Examiner argues that Chishti describes tooth appliance systems of the type fabricated herein (which Applicants freely concede), and that Morrow et al. would suggest coating the Chishti et al. appliances with a lubricious composition "to increase the comfort to the wearer." It is noted that similar rejections were stated against claims 1-18 prior to canceling these claims in the previous Office Action. Thus, it will be assumed that this combination of references would be applied against all pending claims, including those which have now been reintroduced.

While Applicants do not dispute the Examiner's characterization of the individual references, Applicants strongly disagree with the combination which has been asserted by the Examiner. As is well known to the Examiner, *prima facie* obviousness requires not only that the references teach the individual limitations of a particular claim being examined, but also that there must be some suggestion or motivation to modify or combine the references present either in the references themselves or in knowledge generally available to one of ordinary skill in the art. The mere fact that references can

be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. The teaching or suggestion to make the claimed combination must be found in the prior art, not in the Applicant's disclosure. Such basic requirements for *prima facie* obviousness are discussed in MPEP § 2143.

The Examiner's assertion that the combination of the coatings of Morrow with the systems of Chishti "is considered to be an obvious matter of choice to one skilled in the art" is clearly insufficient to support a finding of obviousness. Nor is the Examiner's assertion that the combination would be obvious "in view of the Morrow et al. teaching that such a . . . [lubricious] . . . composition applied to a mouthpiece allows for greater comfort to the wearer."

The mouthpieces of Morrow et al. are directed at "athletic mouth protectors" (Col. 2, line 18) which are intended to "reduce the number of injuries to the structures of the oral cavity suffered by athletes participating in contact sports." (Col. 2, lines 30-32). Nowhere does Morrow et al. discuss the use of orthodontic techniques for moving teeth, as is the purpose of the Chishti et al. system. The Chishti et al. patent, in contrast, is directed at orthodontic systems intended to move teeth. In particular, Chishti et al. uses a plurality of polymeric shell appliances which fit over the teeth, engage the teeth by friction, and move the teeth by imparting an elastic recoil from the appliance to the individual teeth. Nowhere in Chishti et al. is it described or noted that providing a lubricious coating or somehow reducing friction between the appliance and underlying teeth would be desirable.

The only source suggesting the desirability of increasing the comfort of the Chishti et al. appliances is found in the present application, e.g. at page, line 21. Reliance on this teaching for explaining the desirability of combining the prior art, however, is expressly forbidden by the MPEP and underlying case law.

Thus, unless the Examiner is able to point to suitable motivation, either in the prior art references or in knowledge generally available to those of ordinary skill in

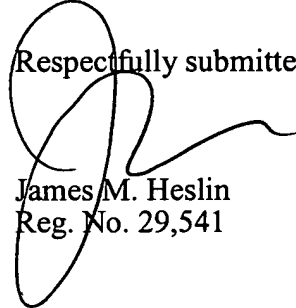
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the art, it is respectfully submitted that the stated combination of references is unsupported and requested that the rejections be withdrawn.

If for any reason the Examiner believes that a telephone conference would in any way expedite prosecution of the subject application, the Examiner is invited to telephone the undersigned at (650) 326-2400.

Respectfully submitted,



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